

TREXLER, BUSHNELL, GIANGIORGI, BLACKSTONE & MARR, LTD.
COUNSELORS AT LAW

RICHARD R. TREXLER (1906-1995)
RICHARD BUSHNELL (1926-2004)
RICHARD A. GIANGIORGI
RAIFORD A. BLACKSTONE, JR.
DAVID J. MARR
LINDA L. PALOMAR
JAMES R. FOLEY
ROBERT J. DEPKE
JAMES A. O'MALLEY
TIMOTHY M. MCCARTHY
PAIGE A. KITZINGER

THE CLARK ADAMS BUILDING
105 WEST ADAMS STREET, SUITE 3600
CHICAGO, ILLINOIS 60603-6210
(312) 704-1890

FOUNDED 1890

PATENT, TRADEMARK, COPYRIGHT
AND RELATED MATTERS; ALL PHASES
INCLUDING LICENSING AND LITIGATION

FAX: (312) 704-8023
www.trexlaw.com

RECEIVED
CENTRAL FAX CENTER

APR 28 2006

LEWIS T. STEADMAN, SR.
OF COUNSEL

FACSIMILE TRANSMISSION

TOTAL PAGES (Including Cover Page) 11 DATE: April 28, 2006

United States Patent and Trademark Office
TO: Attn: Examiner Guiyoung Lee FROM: Mr. James R. Foley, Reg. No. 39,979

FAX NO: (571) 273-8300 FAX NO: (312) 704-8023

If you experience any difficulty with this transmission, please call (312) 704-1890 for assistance.

ORIGINAL COPY AND ENCLOSURES

☐ WILL BE SENT BY ☐ MAIL ☐ COURIER
☒ WILL NOT BE SENT

NOTES:

Inventor: Gary E. Hendricks
For: Headlamp adjuster with expandable
member for accommodating retraction
of an adjuster output member
Art Unit: 2875
Serial No.: 10/689,481
Filed: October 20, 2003
Attorney Ref.: 140/41302/Case 994



IMPORTANT NOTICE

This transmission (including all attached pages) is intended only for the use of the named addressee(s), and may contain information that is privileged or exempt from disclosure under applicable law. **IF YOU ARE NOT A NAMED ADDRESSEE, YOU ARE HEREBY NOTIFIED THAT ANY USE, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS TRANSMISSION IS STRICTLY PROHIBITED.** If you have received this transmission in error, please destroy all copies and notify us immediately at this telephone number: (312) 704-1890.

BEST AVAILABLE COPY

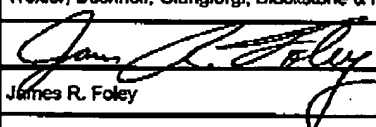
APR 28 2006

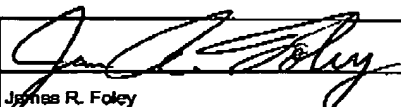
PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/689,481
	Filing Date	October 20, 2003
	First Named Inventor	Gary E. Hendricks
	Art Unit	2875
	Examiner Name	Gulyoung Lee
Total Number of Pages in This Submission	Attorney Docket Number	140/41302/Case 994

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Notice of Appeal PTO/SB/31, Pre-Appeal Brief Request for Review PTO/SB/33, and Reasons for Review
Remarks The Commissioner is hereby authorized to charge any fees due or to credit any overpayment to Deposit Account No. 20-1495. A duplicate copy of this sheet is enclosed.		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Trexler, Bushnell, Gianglori, Blackstone & Marr, Ltd.	
Signature		
Printed name	James R. Foley	
Date	April 28, 2006	Reg. No. 39,979

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name	James R. Foley	Date April 28, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

APR 28 2006

PTO/SB/21 (09-04)

Approved for use through 07/31/2006, OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/689,481
	Filing Date	October 20, 2003
	First Named Inventor	Gary E. Hendricks
	Art Unit	2875
	Examiner Name	Guiryoung Lee
Total Number of Pages in This Submission	Attorney Docket Number	140/41302/Case 994

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Notice of Appeal PTO/SB/31, Pre-Appeal Brief Request for Review PTO/SB/33, and Reasons for Review
Remarks The Commissioner is hereby authorized to charge any fees due or to credit any overpayment to Deposit Account No. 20-1495. A duplicate copy of this sheet is enclosed.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Trexler, Bushnell, Glanglori, Blackstone & Marr, Ltd.		
Signature			
Printed name	James R. Foley		
Date	April 28, 2006	Reg. No.	39,979

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name	James R. Foley	Date	April 28, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

BEST AVAILABLE COPY

COPY

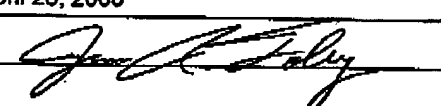
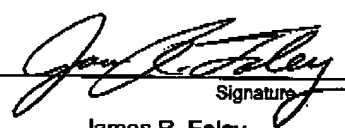
RECEIVED
CENTRAL FAX CENTER

APR 28 2006

Doc Code: AP.PRE.REQ

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Approved for use through xx/xx/200x. OMB 0651-000x
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 140/41302/Case 994	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a)) on <u>April 28, 2006</u> Signature <u></u> Typed or printed name <u>James R. Foley</u>		Application Number 10/689,481	Filed October 20, 2003
		First Named Inventor Gary E. Hendricks	
		Art Unit 2875	Examiner Guiyoung Lee
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 39,979 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u></u> Signature James R. Foley Typed or printed name 312-704-1890 Telephone number April 28, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

BEST AVAILABLE COPY

REASONS FOR REVIEW

At the time of the filing of the Notice of Appeal concurrently with this Pre-Appeal Brief Request for Review, claims 1-18 were present in the application.

The following rejections were made in the last Office Action:

- a. Claims 1-2, 8-12 and 16-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,450,674 (Denley) in view of United States Patent No. 6,471,386 (Oh);
- b. Claims 3-4 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Denley and United States Patent No. 5,927,071 (Asanuma et al.);
- c. Claims 7 and 15 were rejected as being unpatentable over a combination of Oh and United States Patent No. 6,779,835 (Fox et al.); and
- d. Claims 5-6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Oh and United States Publication No. 2004/0086324 (Bertram et al.).

Applicant respectfully submits that the rejections of claims 1-18 should be withdrawn for the reasons stated in pages 2-9 of Applicant's Response to the Office Action of February 9, 2006, as well as the reasons stated herein.

Independent claim 1 claims a rotatable input member, gearing in the housing configured to provide that rotation of the rotatable input member causes extension and retraction of said adjuster member, that the adjuster member is extendable and retractable into and out of contact with the expandable member and that the adjuster member is configured to be retractable to such

Serial No.: 10/689,481

Page 1

BEST AVAILABLE COPY

an extent that the end of the adjuster member contacts and pushes on the expandable member. Also claimed is the fact that the expandable member is configured to expand upon the end of the adjuster member contacting and pushing on the expandable member to accommodate retraction of the adjuster member. Claim 11 is similar, but is directed to a method.

In the Office Action, the Examiner rejected claims 1-2, 8-12 and 16-18 under 35 U.S.C. 13(a) as being unpatentable over a combination of Denley and Oh. According to the Examiner, Denley teaches the claimed invention except for an expandable member, and Oh teaches an expandable member. Specifically, the Examiner asserts that "Oh discloses an expandable member (13), and that the expandable member is configured to expand upon said second end of said adjuster member contacting and pushing on said expandable member." Applicant respectfully asserts that the Examiner is misinterpreting Oh. While the Examiner asserts that part number 15 is an adjuster member, part number 15 is merely a snap fitting pin. While Oh does disclose a bellows spring bracket (part number 13), the bellows is not used to accommodate the retraction of an adjuster member upon rotation of a rotatable input member. In Oh, there is no input member which is rotatable to cause the snap fitting pin 15 to retract such that an end of the pin 15 contacts and pushes on part 13. In contrast, the bellows spring bracket is provided merely to withstand impact (see, for example, col. 3, lines 37-40). In Oh, the end of part number 15 is not retractable such that it contacts part number 13, and part number 13 does not expand to accommodate the retraction. Again, Applicant respectfully asserts that the Examiner is misinterpreting the Oh reference.

Furthermore, even if Oh did disclose what the Examiner asserts, Applicant submits that there is no motivation in the prior art to combine Denley and Oh as asserted by the Examiner.

Serial No.: 10/689,481

Page 2

BEST AVAILABLE COPY

In the present case, the Examiner has not identified any suggestion or incentive to combine the references indicated in the Office Action, other than referring to the present invention itself. As such, Applicant respectfully submits that the combination of Denley and Oh asserted by the Examiner is improper, and the rejection should be withdrawn. Also, as described above, Applicant respectfully submits that Oh does not disclose what the Examiner asserts that Oh discloses. As such, even if Denley and Oh were to be combined, one would not arrive at the present invention.

Applicant respectfully asserts that not only is there no motivation to combine Denley and Oh as the Examiner asserts, but that the Denley reference teaches away from such a modification (i.e., to provide an expandable member which is configured to expand upon an end of the adjuster member contacting and pushing on the expandable member). In Denley (see col. 4, lines 45-50, as well as col. 6, lines 22-37, and col. 12, lines 26-43), member 190c is described as having an internal stop wall 124a which works to limit retraction (as opposed to accommodate retraction as in the present invention) of the adjuster output shaft 104a (viz-a-viz contact between the end 122a of the adjuster output shaft 104a and the internal stop wall 124a of member 190c).

In light of the foregoing, Applicant respectfully asserts that the rejection of claims 1-2, 8-12 and 16-18 under 35 U.S.C. 103(a) as being unpatentable over a combination of Denley and Oh should be withdrawn.

In the Office Action, the Examiner also rejected claims 3-4 and 13 under 35 U.S.C. 103(a) as being unpatentable over a combination of Denley and Asanuma et al. In making the rejection, the Examiner discusses Oh and Asanuma et al. Therefore, it is unclear whether the Examiner meant to reject claims 3-4 and 13 under 35 U.S.C. 103(a) as being unpatentable over a

Serial No.: 10/689,481

Page 3

BEST AVAILABLE COPY

combination of Denley, Oh and Asanuma et al., or a combination of only Oh and Asanuma et al. Regardless, Applicant respectfully traverses. As discussed above, Denley does not teach any expandable member and instead discloses member 190c as having an internal stop wall 124a which works to limit retraction (as opposed to accommodate retraction as in the present invention) of the adjuster output shaft 104a (viz-a-viz contact between the end 122a of the adjuster output shaft 104a and the internal stop wall 124a of member 190c). As such, Applicant respectfully asserts that Denley teaches away from a modification which includes an expandable member that is contacted by an adjuster output shaft during its retraction, whether the expandable member is made out of rubber or not (as set forth in claims 3-4 and 13). Additionally, as described above, Applicant respectfully asserts that the Examiner is misinterpreting Oh. While the Examiner asserts that part number 15 is an adjuster member, part number 15 is merely a snap fitting pin. While Oh does disclose a bellows spring bracket (part number 13), the bellows is not used to accommodate the retraction of an adjuster member upon rotation of a rotatable input member. In Oh, there is no input member which is rotatable to cause the snap fitting pin 15 to retract such that an end of the pin 15 contacts and pushes on part 13. In contrast, the bellows spring bracket is provided merely to withstand impact (see, for example, col. 3, lines 37-40). In Oh, the end of part number 15 is not retractable such that it contacts part number 13, and part number 13 does not expand to accommodate the retraction. Applicant respectfully asserts that the rejection of claims 3-4 and 13 should be withdrawn.

In the Office Action, the Examiner also rejected claims 7 and 15 under 35 U.S.C. 103(a) as being unpatentable over a combination of Oh and United States Patent No. 6,779,835 (Fox et al.), and rejected claims 5-6 and 14 under 35 U.S.C. 103(a) as being unpatentable over a

Serial No.: 10/689,481

Page 4

BEST AVAILABLE COPY

combination of Oh and United States Patent Application Publication No. 2004/0086324 (Bertram et al.). As described above, Applicant respectfully asserts that the Examiner is misinterpreting Oh, and that Oh does not disclose an expandable member that is configured to expand upon an end of an adjuster member contacting and pushing on the expandable member. Additionally, in Oh, there is no input member which is rotatable to cause the snap fitting pin 15 to retract such that an end of the pin 15 contacts and pushes on part 13. In contrast, the bellows spring bracket is provided merely to withstand impact (see, for example, col. 3, lines 37-40). In Oh, the end of part number 15 is not retractable such that it contacts part number 13, and part number 13 does not expand to accommodate the retraction. Applicant respectfully asserts that the rejection of claims 7 and 15 citing a combination of Oh and Fox et al. should be withdrawn, and that the rejection of claims 5-6 and 14 citing a combination of Oh and Bertram et al. should be withdrawn.

Applicant respectfully asserts that claims 1 and 11 of the present application, and those claims which depend therefrom, are allowable, and that the present application should be passed to issuance.

Respectfully submitted,

Date: April 28, 2006

By: 

Richard A. Giangiorgi, Reg. No. 24,284

James R. Foley, Reg. No. 39,979

Attorneys for Applicant

Trexler, Bushnell, Giangiorgi,

Blackstone & Marr, Ltd.

105 West Adams Street, 36th Floor

Chicago, Illinois 60603-6299

Tel: (312) 704-1890

Serial No.: 10/689,481

Page 5

BEST AVAILABLE COPY